

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REEXAMINATION

CONTROL NUMBER: 95/000,010
PATENT: 6,375,169
DATE OF ISSUE: April 23, 2002
NAME OF PATENTEE: Kevin N. McCraw
TITLE OF INVENTION: MATTRESS SPRING CUSHION ASSEMBLY WITH
COMBINATION OF RIGHT-HAND AND LEFT-HAND SPRING
UNITS

Cincinnati, Ohio 45202

December 9, 2008

Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST OF THIRD PARTY REQUESTER
FOR RECONSIDERATION OF CRU DIRECTOR'S DECISION TO
EXPUNGE THIRD PARTY REQUESTOR'S COMMENTS
TO APPELLANT'S REBUTTAL BRIEF

In an Office Action dated December 1, 2008, the Central Reexamination Unit Director has expunged and returned the "Comments of Third Party Requester to Appellant's Rebuttal Brief". This decision is in error and it is respectfully requested by the third party requester that this decision be reversed and that the Comments be returned to the record. Apparently, that return to the record does not require physical return of these papers since they have been marked "closed and not published", but not returned.

Attached hereto as Exhibit A is a chronology of the entries in this Inter Partes proceeding. As can be seen from that chronology, this expedited [see 37 CFR § 1.937(a)] Inter Partes reexamination has now gone on for over four years just to reach the stage that

a record has been created preparatory to a decision by the Board of Patent Office Appeals and Interferences.

As the basis for expunging the third party requester's comments, the Director has relied upon 37 CFR § 41.66. That section is titled "Time for filing briefs" and it is submitted, applies only to appellant's brief 37 CFR § 41.66(a), respondent's brief (37 CFR § 41.66(b), examiner's answer (37 CFR § 41.66(c), and appellant's rebuttal brief (37 CFR § 41.66(d). In part (e) of this section, it is provided that:

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

It is Part (e) upon which the Director has relied in expunging and returning the third party requester's comments. It is submitted that 37 CFR § 41.66 applies only to the filing of appeal briefs, examiner's answer and rebuttal briefs by the appellant, but does not apply to third party requester's comments on such rebuttal briefs. If no further "submissions" applies to third party requester comments, then a third party in an Inter Partes proceeding will be unable to make any submission or file any papers subsequent to the examiner's answer to be considered by the Board of Appeals in making its decision. Specifically, according to the record in this file, the Board of Appeals could only consider the Examiner's second Office Action closing the prosecution of the Inter Partes proceeding, the Patent Owner's Appeal Brief, the Comments of the Third Party Requester to the Patent Owner's Brief, the Examiner's Answer to the Patent Owner's Appeal Brief and Patent Owner's Rebuttal Brief. The third party request would be shut out of the proceedings subsequent to the filing of the Examiner's Answer to an Appeal Brief even if the rebuttal brief is factually inaccurate or misleading. That is absolutely inconsistent with Part (a) of 37 CFR § 1.947 which provides that:

"Each time the Patent Owner files a response to an Office Action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response."

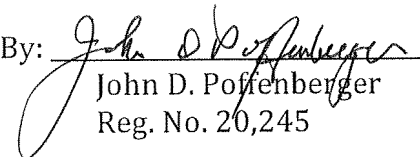
The Action taken sua sponte in expunging and returning the third party requester's comments in this case is absolutely inconsistent with 37 CFR § 1.947 set forth hereinabove. It also prematurely cuts off the third party requester in very nearly every appeal to the Board of Patent Appeals and Interferences from the appeal proceedings before the Board. That is clearly not the intention of Inter Partes proceedings.

Summarizing, it is submitted that the inconsistency by the Director's interpretation of 37 CFR §41.66 and 37 CFR §1.947 should be resolved in favor of the third party requester in this case and Applicant's comments made of record for the benefit of the Board of Appeals in making its decision.

No fee is believed to be due. In the event that fees are due, the Office is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By: 
John D. Poffenberger
Reg. No. 20,245

2700 Carew Tower
Cincinnati, Ohio 45202
(513) 241-2324

EXHIBIT A

Chronology

Filed

- | | | |
|-----|--|-------------------|
| 1. | Request for Inter Partes Reexamination filed | March 12, 2003 |
| 2. | Request for Inter Partes Reexamination granted | May 27, 2003 |
| 3. | First Office Action in Reexamination –
all claims rejected | June 11, 2003 |
| 4. | Patent Owner's Amendment and
Response to First Office Action Filed | August 5, 2003 |
| 5. | Comments of Third Party Requester filed | August 20, 2003 |
| 6. | Patent Owner's Supplemental
Response to First Office Action filed | August 26, 2003 |
| 7. | Action Closing Prosecution issued –
all claims rejected | February 25, 2004 |
| 8. | Patent Owner's Second Supplemental
Response to First Office Action filed | December 7, 2004 |
| 9. | Comments of Third Party Requester Responsive to
Patent Owner's Second Supplemental Response filed | December 29, 2004 |
| 10. | Patent Owner's Comments in Response to
Comments of Third Party Requester Filed | January 7, 2005 |
| 11. | Second Action Closing Prosecution issued –
all claims rejected | May 24, 2005 |
| 12. | Patent Owner's Comments to
Second Office Action Closing Prosecution filed | June 21, 2005 |
| 13. | Comments of Third Party Requester
Responsive to Patent Owner's Comments filed | June 30, 2005 |
| 14. | Communication from Patent Office
Setting Time for Appeal issued | October 4, 2005 |
| 15. | Notice of Appeal filed by Patent Owner | October 31, 2005 |

Chronology**Filed**

- | | | |
|-----|---|-------------------|
| 16. | Patent Owner's Appeal Brief filed | December 28, 2005 |
| 17. | Comments of Third Party Requester to Patent Owner's Brief filed | January 17, 2006 |
| 18. | Patent Office Notice that Patent Owner's Appeal Brief Defective | April 7, 2006 |
| 19. | Patent Owner's Corrected Appeal Brief filed | May 4, 2006 |
| 20. | Examiner's Answer to Patent Owner's Appeal Brief and Third Party Requester Comments filed—all claims rejected | October 3, 2007 |
| 21. | Patent Owner's Rebuttal Brief filed | October 26, 2007 |
| 22. | Comments of Third Party Requester Responsive to Patent Owner's Rebuttal Brief filed | November 15, 2007 |
| 23. | CRU Examiner Notice Mailed that Patent Owner's Rebuttal Brief and Requester's Comments in Reply to Rebuttal Brief had both been entered and that no further response by Examiner is appropriate | February 25, 2008 |
| 24. | Patent Office Notice mailed to Third Party Requester that Third Party Requester's Comments filed on November 25, 2007 in response to Patent Owner's Rebuttal Brief is expunged from record and returned as untimely filed | December 1, 2008 |

CERTIFICATE OF SERVICE

I hereby certify that the foregoing REQUEST OF THIRD PARTY REQUESTER FOR RECONSIDERATION OF CRU DIRECTOR'S DECISION TO EXPUNGE THIRD PARTY REQUESTOR'S COMMENTS TO APPELLANT'S REBUTTAL BRIEF is being served upon counsel for the patent owner herein via Certified Mail on this 9th day of December, 2008 at the following address:

Karl S. Sawyer, Jr.
Kennedy Covington Lobdell & Hickman, L.L.P.
Hearst Tower, 47th floor
214 North Tryon Street
Charlotte, North Carolina 28202

12/9/08
Date

John D. Poffenberger
John D. Poffenberger